

REMARKS

Applicant thanks Examiner Vu for the telephone conference on July 25, 2006 and for his thoughtful consideration of this case. This Application has been carefully reviewed in light of the Office Action mailed August 14, 2006 ("Office Action"). To clarify various aspects of inventive subject matter and in some cases to remove unnecessary limitations, Applicant amends Claims 65, 66, and 83. Applicant also introduces new Claims 92-94 and cancels Claims 78, 86, and 89 without prejudice or disclaimer. To advance prosecution of this application, Applicant has responded to each notation by the Examiner. Applicant submits that all of the pending claims are allowable over the cited references. Applicant respectfully requests reconsideration, further examination, and favorable action in this case.

Interview Summary

Applicant's attorney conducted a telephonic conference with Examiner Vu on July 25, 2006. Pursuant to M.P.E.P. §713.04, Applicant submits this summary of the telephonic interview to record Applicant's understanding of the substance of the interview. If Applicant's understanding is inaccurate, notice of such is appreciated.

During the interview, Applicant and the Examiner discussed the Restriction. Applicant elected to prosecute Group III (Claims 65-66, 83-88, and 90-91).

Response to Election/Restriction

In response to the Official Action mailed August 14, 2006 and a telephone interview with the Examiner, solely for the purpose of advancing prosecution of this case and without addressing the veracity of Examiner's election requirement, Applicant hereby elects to prosecute Group III (Claims 65-66, 83-88, and 90-91) without traverse. Groups I-III and V (Claims 58-64, 68-69, 89, and 71-82) are withdrawn from the above-identified patent application without prejudice or disclaimer. This election is made solely to expedite issuance of a patent from this Application. Applicant does not necessarily agree with or acquiesce to the Examiner's conclusion reflected in the Office Action.

Claim Rejections under 35 U.S.C. § 103

The Examiner rejected Claims 65-66, 83-89, and 91 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2002/0064164 A1 by Boroditsky et al.

(“*Boroditsky*”) in view of U.S. Patent Serial No. 6,285,810 B1 issued to Fincato et al. (“*Fincato*”). Applicant respectfully traverses these rejections for the reasons discussed below.

A. The Proposed Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in the Independent Claims

Applicant provides a reminder that to defeat a patent under 35 U.S.C. § 103, “the prior art references must teach, disclose, or suggest all the claim limitations.” *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 706.02(j). Applicant respectfully submits that none of the cited references, taken alone or in combination, teach or suggest, either expressly or inherently, a number of elements of the independent or dependent Claims.

Applicant submits that amended independent Claim 65 is patentable over *Boroditsky* in view of *Fincato*. Among other features, amended independent Claim 65 recites, in part, “generating, based on the first packet, an optical output packet comprising the payload and having a second duration shorter than the first duration, the optical output packet having a first wavelength and wherein the optical output packet comprises a substantially continuous spectrum centered at the first wavelength.” Amended claim 65 also recites, in part, “communicating a control signal to at least a selected filter associated with a communication path to a destination element, the control signal operable to cause the selected filter to accept the optical output packet and to facilitate communicating at least the payload of the optical output packet toward the destination element, wherein the control signal is centered at the first wavelength.”

Boroditsky fails to disclose, teach or suggest a number of elements of amended Claim 65. For example, nowhere does *Boroditsky* disclose, teach, or suggest generating an optical output packet having a second duration shorter than the first duration and a first wavelength, where the optical output packet comprises a substantially continuous spectrum centered at the first wavelength. Moreover, *Boroditsky* fails to contemplate communicating a control signal to at least a selected filter associated with a communication path to a destination element, the control signal operable to cause the selected filter to accept the optical output packet and to facilitate communicating at least the payload of the optical output packet toward the destination element, wherein the control signal is centered at the first wavelength. Consequently, *Boroditsky* fails to teach or suggest “generating, based on the first packet, an

optical output packet comprising the payload and having a second duration shorter than the first duration, the optical output packet having a first wavelength and wherein the optical output packet comprises a substantially continuous spectrum centered at the first wavelength” and “communicating a control signal to at least a selected filter associated with a communication path to a destination element, the control signal operable to cause the selected filter to accept the optical output packet and to facilitate communicating at least the payload of the optical output packet toward the destination element, wherein the control signal is centered at the first wavelength.”

Fincato fails to atone for the deficiencies of *Boroditsky*. For example, nowhere does *Fincato* disclose, teach, or suggest an optical output packet having a second duration shorter than the first duration and a first wavelength, where the optical output packet comprises a substantially continuous spectrum centered at the first wavelength. Moreover, *Fincato* fails to contemplate communicating a control signal to at least a selected filter associated with a communication path to a destination element, the control signal operable to cause the selected filter to accept the optical output packet and to facilitate communicating at least the payload of the optical output packet toward the destination element, wherein the control signal is centered at the first wavelength. Consequently, *Fincato* fails to teach or suggest “generating, based on the first packet, an optical output packet comprising the payload and having a second duration shorter than the first duration, the optical output packet having a first wavelength and wherein the optical output packet comprises a substantially continuous spectrum centered at the first wavelength” and “communicating a control signal to at least a selected filter associated with a communication path to a destination element, the control signal operable to cause the selected filter to accept the optical output packet and to facilitate communicating at least the payload of the optical output packet toward the destination element, wherein the control signal is centered at the first wavelength.”

For at least these reasons, Applicant submits that *Boroditsky* and *Fincato*, taken alone or in combination, fail to teach or suggest amended Claim 65. Applicant respectfully requests withdrawal of the rejection and full allowance of amended independent Claim 65 and all claims depending therefrom.

Applicant submits that amended independent Claim 83 is patentable over *Boroditsky* in view of *Fincato* for at least the reasons discussed above. Thus, Applicant respectfully

requests withdrawal of the rejection and full allowance of amended Claim 83 and all claims depending therefrom.

B. The Proposed Combinations are Improper

The rejection of Applicant's claims is also improper because the Examiner has not shown the required teaching, suggestion, or motivation in *Boroditsky*, *Fincato*, or in the knowledge generally available to those of ordinary skill in the art at the time of the invention to combine or modify the *Boroditsky*, *Fincato*, and/or with information known by the Examiner in the manner the Examiner proposes. The rejected claims are allowable for at least this additional reason.

1. The Obviousness Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Boroditsky* and *Fincato* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Respectfully, it appears to Applicant that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicant's claims as a blueprint, in an attempt to reconstruct Applicant's claims.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

. . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* *Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”* *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). See also *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (*holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine*); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. See *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “*The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*” M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based

on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also,* e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembicza*k, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

2. Argument

The Examiner states:

In the same field of endeavor, *Fincato* discloses a tunable add/drop optical device including a control signal [*Fincato*. detected signal usable by tuning control loop for maintaining optimal tuning of filter on the selected channel. . . .]

(Office Action, Page 5). Thus, the Examiner characterizes *Boroditsky* and *Fincato* as being “from the same field of endeavor,” and then concludes that it would have been obvious to combine them. (Office Action, Page 5) First, Applicant does not agree that a reference directed to composit packet-switching over WDM by transparent photonic slot routing (*Boroditsky*) is necessarily “from the same field of endeavor” as a reference directed to tunable add/drop optical devices. (*Fincato*). However, even assuming that *Boroditsky* and *Fincato* are at least marginally in the same general field of endeavor, the Examiner has not demonstrated the requisite teaching, suggestion, or motivation in either of these references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicants’ invention to combine or modify these references in the manner the Examiner proposes.

According to the Examiner, it would have been obvious to a person of skill in the art at the time the invention was made to combine the teachings of *Boroditsky* with *Fincato*. The Examiner provides essentially no support in either the *Boroditsky* reference or in the *Fincato* reference for this assertion. *Id.* Applicant respectfully submits that the Examiner's assertion that it would have been obvious to modify the teachings of *Boroditsky* with *Fincato* to purportedly arrive at Applicant's invention is entirely insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law. Consequently, the Examiner has not demonstrated the requisite teaching, suggestion, or motivation in either of the reference or in the knowledge that is supposedly generally available to one of ordinary skill in the art at the time of Applicant's invention to combine or modify these references in the manner the Examiner proposes.

It appears that the Examiner is merely proposing alleged advantages of modifying *Boroditsky* with *Fincato* (advantages which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has cited portions of *Boroditsky* and *Fincato* the Examiner has not pointed to any portions of the cited references or to knowledge supposedly generally available to those of ordinary skill in the art at the time of the invention that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to modify the system disclosed in *Boroditsky* with *Fincato* as suggested by the Examiner. In other words, the alleged advantage of the system described by the Examiner does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (**without using Applicant's claims as a guide**) to modify the particular techniques disclosed in *Boroditsky* as suggested by the Examiner; (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so; and (3) how doing so would purportedly meet the limitations of the claims. Indeed, if it were sufficient for Examiners to merely point to a purported advantage and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

It certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the system disclosed in *Boroditsky* with *Fincato* in the manner proposed by the Examiner. Applicant respectfully submits that the Examiner's attempt to modify or combine *Boroditsky* with *Fincato* appears to constitute the type of impermissible hindsight reconstruction of Applicant's claims, using Applicant's claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to modify *Boroditsky* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

Consequently, a *prima facie* case of obviousness cannot be maintained with respect to dependents Claims 65-66, 83-89, and 91, as the Examiner has not show the requisite proof necessary to establish a suggestion or motivation to combine the cited references.

D. Conclusion

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 65-66, 83-89, and 91.

No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the *Boroditsky* and *Fincato* references. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the anticipation and obviousness rejections.

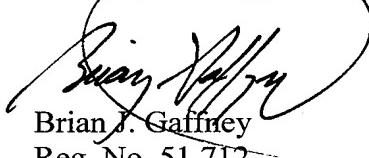
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully request reconsideration and full allowance of all pending Claims.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

If the Examiner feels that a conference would advance prosecution of this Application in any manner, Brian J. Gaffney stands willing to conduct such a telephone interview at the convenience of the Examiner. Mr. Gaffney may be reached at (214) 953-6682.

Respectfully submitted,
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